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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1940.

No. 277

THE AUTOMATIC DEVICES CORPORATION,
Petitioner,

vs.

SINKO TOOL & MANUFACTURING COMPANY,
Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI.

BERNARD A. SCHROEDER,
RUSSELL WILES,
GEORGE A. CHRITTON,
Counsel for Respondent.

March 25, 1941.
Chicago, Ill.

THE DUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

On October 14, 1940 this Court denied a petition for writ of certiorari to review the decree of the United States Circuit Court of Appeals for the Seventh Circuit, entered April 27, 1940.

Petitioner is now asking for a rehearing of its petition on the grounds that on February 3, 1941, the Court of Appeals for the Second Circuit handed down a decision in the case of *The Automatic Devices Corporation* v. *The Cuno Engineering Corporation* holding the Mead patent valid and infringed by a Cuno cigar lighter. The Court of Appeals for the Seventh Circuit has held the same patent not infringed by respondent's Sinko cigar lighter and that the patent is invalid.

Respondent's Reasons for Opposition.

Respondent opposes the petition for rehearing or allowance of the writ in the present case for the following reasons:

1. There is no conflict between the decisions of the Circuit Court of Appeals for the Second Circuit and the Circuit Court of Appeals for the Seventh Circuit *on any of the questions presented in the petition* for writ of certiorari in the present case, No. 277.

2. The statutory period for filing a new petition for a writ of certiorari has expired.

3. There are no new facts or newly discovered evidence that existed during the statutory period that would warrant the asking of this Court to reverse its denial of the writ on October 14, 1940.

4. More than twenty-five days have elapsed since this Court denied the petition for certiorari, and the time for filing a petition for rehearing has not been enlarged by order of this Court under Rule 33.

There Is No Conflict in the Questions Presented.

An examination of the petition for writ of certiorari, No. 277, will show that petitioner did not ask this Court to review the question of the validity of the Mead patent. The questions presented appear on pages 2 and 3 of the original petition and may be stated as follows:

1. Whether the defense of invalidity had been abandoned in the District Court and could properly be considered by the Court of Appeals. The only question was whether defendant was precluded or estopped to raise the question of validity. The District Court and Court of Appeals had held against the petitioner on this alleged abandonment and this Court declined to review the question, which was merely one of fact.

2. The second question was whether the Cohen patent was properly held invalid. Both of the District Courts and both of the Courts of Appeals agreed that this patent is invalid. That part of the petition has been withdrawn.

3. The only other question raised by the petition was whether the cigar lighter of respondent avoided infringement by the structure employed. Assuming that respondent was precluded or estopped to deny validity under question (1.) above, the question of infringement by the particular structure of respondent was questioned.

The Cuno lighter held to infringe in the Second Circuit is very different in construction from the Sinko lighter of respondent, as we will point out below, and of course the Circuit Court of Appeals for the Second Circuit did not consider the Sinko lighter or have jurisdiction to review the finding of non-infringement in the Court of Appeals for the Seventh Circuit.

Petitioner has attached to its present motion for leave to file petition for rehearing, an affidavit by its president,

Mr. Johnson, together with a drawing of the Sinko device, one of the Cuno device, but none of the Mead patent device. In the Mead device there is no relative movement between the handle and sleeve of the plug. The affidavit describes the Sinko and Cuno devices, admits important structural differences and says "in the Sinko device and in the Mead device the same results are obtained in substantially the same way and by the same means." We submit that such a statement is untrue, is contrary to the decision of the Court of Appeals for the Seventh Circuit which reviewed affiant's testimony, and is contrary to the law as stated by this Court. Surely a partisan patent solicitor has no right to substitute his opinion for that of three Judges of a Court of Appeals which had jurisdiction and did pass on this question.

The structural differences between the Sinko lighter and that of either Mead or Cuno are very significant.

As a matter of fact, the Cuno lighter has a different combination of elements and was charged to infringe claim 1 of the Mead patent which was not even asserted against respondent Sinko's lighter.

The claims in the Mead patent are directed to the active combination of a removable igniter plug, a socket for holding the plug, and thermostatic means which cooperate with both the plug and socket. In the Mead device and the Cuno lighter there is a proper active combination of plug and socket because the thermostat is secured to the socket and latches the removable plug in the socket. The reason the socket member is claimed in the combination is because it is an active part in the combination.

In the Sinko device, on the other hand, the thermostat is wholly within the plug and does not cooperate in any way, with any part, of the old socket. The thermostat will operate in exactly the same way without a socket member. The Sinko plug and socket is an old combination found

in any cigar lighter having a socket and removable plug. Under the decision of this Court in *Lincoln Engineering Co.* v. *Stewart Warner*, 303 U. S. 545, a claim for such an exhausted combination is invalid. In other words, if Mead had disclosed respondent's structure, with no new cooperation between the plug and socket, he could not have made the claims in suit because the combination between the plug and socket was old, exhausted, and unpatentable. This argument does not apply to Mead's actual structure, or to that of the Cuno device, but only to the Sinko device. Accordingly, we submit that if the claims in suit could not have been made on a disclosure of defendant's structure, by the same token, defendant's structure does not infringe.

Statutory Period for a New Petition for Writ of Certiorari Has Expired.

More than ninety days have elapsed since the decision was handed down by the Court of Appeals for the Seventh Circuit. Accordingly, it is too late to file a new petition and we have shown that there is no conflict between the decisions of the two Circuits on the *questions presented* in the original petition. Petitioner does not allege there is a conflict. In *General Talking Pictures Corp.* v. *Western Electric*, 304 U. S. 173, 179, this Court said:

> "Petitioner is not here entitled to decision on any question other than those formally presented by its petition for the writ."

In *Johnson* v. *Manhattan Railway Co.*, 289 U. S. 477, 494, it was held that the review granted by this Court by writ of certiorari is not broader than that sought in the petition for the writ. Accordingly, the petitioner is not now entitled, in the present case, to ask for a review of the question of validity of the Mead patent.

There Are No New Facts Upon Which to Reverse the Decision of This Court on October 14, 1940 Denying a Petition for Writ of Certiorari.

The only new point upon which petitioner bases its request for rehearing is the decision of the Court of Appeals for the Second Circuit which was not handed down until February 3, 1941. By that time, not only had the petition for writ of certiorari been denied in the present case, but the motion of petitioner to withhold notice of denial of the petition had been denied, the mandate of the Court of Appeals for the Seventh Circuit had been sent down to the District Court, and costs had been assessed and paid. We submit that it would be a great hardship on respondent to grant a writ at this late date.

The Usual Time for Petition for Rehearing Has Gone By.

Rule 33 of this Court provides:

> "A petition for rehearing may be filed with the Clerk, in term time or in vacation, *within twenty-five days* after judgment is entered, unless the time is shortened or enlarged by order of the Court."

So far as respondent knows, no request was made until now, 161 days later, to enlarge the time for filing a petition for rehearing and it is assumed that such a request for enlargement should be made during the twenty-five day period provided for in the Rule.

Conclusion.

The questions raised in the petition for writ of certiorari do not include a request for a review of the finding of invalidity of the Mead patent, and there is no conflict between the decisions of the Circuit Court of Appeals for the Second and Seventh Circuits on any other point or on any of the questions presented.

As the device held to infringe in the Second Circuit is a wholly different device, from that of respondent, and employs a different combination of elements, it is requested that the petition for a renearing be denied.

Respectfully submitted,

BERNARD A. SCHROEDER,
RUSSELL WILES,
GEORGE A. CHRITTON,
Counsel for Respondent.

March 25, 1941.
Chicago, Ill.

SUPREME COURT OF THE UNITED STATES.

No. 6.—October Term, 1941.

The Automatic Devices Corporation, Petitioner, *vs.* Sinko Tool & Manfacturing Company.	On Writ of Certiorari to the United States Circuit Court of Appeals for the Seventh Circuit.

[November 10, 1941.]

Mr. Justice Douglas delivered the opinion of the Court.

This is a companion case to *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, No. 37, decided this day. The court below held that claims 2, 3, and 11 of the Mead patent (No. 1,736,544) were invalid and not infringed. 112 F. (2d) 335. We granted the petition for certiorari limited to the question of validity of those claims. For the reasons stated in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, *supra*, the judgment is

Affirmed.

A true copy.

Test:

Clerk, Supreme Court, U. S.